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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,713	11/30/2000	Naoaki Nii	017.39114X00	1256
20457	7590	10/11/2005	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/725,713

Applicant(s)

NII, NAOAKI

Examiner

Yogesh C. Garg

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 49-58 is/are pending in the application.
- 4a) Of the above claim(s) 49-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. Applicant's amendment received on 4/25/2005 is acknowledged and entered. Claims 1 and 19 are amended and new claims 49-58 have been added. Claims 24-28 are cancelled and claims 29-49 are withdrawn. Currently claims 1-23 and 49-58 are pending for examination.

Election/Restrictions

2. Newly submitted claims 49-58 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Newly submitted claims recite the different species of authorization information that it can indicate, namely: a specific multimedia file, or a group of multimedia files, or a category of multimedia files or a maximum number of multimedia files, or a maximum monetary unit value which are mutually exclusive of each other and were not recited in the originally cited claims 1-23. The originally recited claims recited the use of authorization information to actuate the output device to provide any multimedia content without specifying any relation to any of the cited species, that is newly added claims 49-58.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 49-58 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

3.1. The applicant's arguments filed on 4/25/2005 concerning rejection of claims 1-28 under 35 U.S.C. 112 first paragraph, see Remarks, pages 10-12, have been fully considered but are not persuasive for following reasons:

The limitation, " the content is not provided from the integrated circuit cards", as mentioned in the earlier Office action was not disclosed in the specification originally filed on 11/30/2000. The specification, as originally filed discloses , as an example, that the content provider may be one of many possibilities, see Specification, page 5, paragraph 0016, " The content provider might be a database at a kiosk which includes the host and user IC card interfaces. Alternatively, the content provider might be remote from the kiosk. Further, the content provider might be a personal computer, a notebook computer, a wireless personal terminal, or any other processor system having sufficient memory. ". It also includes any processor system having sufficient memory and a IC card is a processor system can have sufficient memory to store data which can be transmitted to another computer readable medium. Thus, neither the specification states

a definite exclusion of IC card as content provider nor it provides a firm basis for the exclusion of IC card as content provider. See MPEP 2173.05 (i).

In view of the foregoing, the rejection of claims 1-28 under 35 U.S.C. 112 first paragraph is maintained.

3.2. Applicant's arguments, see Remarks pages 12-16, filed 4/5/2005, with respect to the rejection(s) of claim(s) 1-28 under 35 USC 103 (a) have been considered but are moot in view of the new grounds of rejection necessitated due to the current amendments.

This is a Final rejection.

Claim Objections

4. Claim 1 is objected to because of the following informalities: Line 11 of claim recites the limitations, " integrated circuit". The word -card- is missing from this term to recite -integrated circuit card---. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5.1. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation, "the content is not provided from the integrated circuit cards", as mentioned in the earlier Office action was not disclosed in the specification originally filed on 11/30/2000. The specification, as originally filed discloses, as an example, that the content provider may be one of many possibilities, see Specification, page 5, paragraph 0016, "The content provider might be a database at a kiosk which includes the host and user IC card interfaces. Alternatively, the content provider might be remote from the kiosk. Further, the content provider might be a personal computer, a notebook computer, a wireless personal terminal, or any other processor system having sufficient memory. ". It also includes any processor system having sufficient memory and a IC card is a processor system can have sufficient memory to store data which can be transmitted to another computer readable medium. Thus, neither the specification states a definite exclusion of IC card as content provider nor it provides a firm basis for the exclusion of IC card as content provider. See MPEP 2173.05 (i).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6.1. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramachandran et al. (US Patent 6,298,441), hereinafter referred to as Ramachandran in view of Handelman et al. (US Patent 6,298,441), hereinafter, referred to as Handelman.

Note: Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Referring to claim 1. Ramachandran discloses a multimedia content delivery system, comprising:

a content provider providing multimedia files (see at least: col. 3, line 15-col. 4, line 36, wherein ATM is a content provider providing multimedia files including sound recordings, images, TV shows, magazines, newspapers, games, etc.),

a integrated circuit card interface for receipt of a user integrated circuit card containing authorization information (see at least col. 7, lines 23-29, which discloses a card reader 20 for receipt of an user smart card to be used to identify a user along with other information such as his accounts. Note: Addressing the card reader or the card as first or second does not add any patentable or novelty because that does not change either the structure or the functions);

an input device for selecting at least one multimedia file from the plurality of multimedia files (see at least: col. 4, lines 37-59),

an output device for providing the content of an authorized multimedia file provided by the content provider to a user of the user integrated circuit card (see at least: col. 4, lines 37-59, col. 7, lines 23-42 which teach reading the information from the user's smart card to authorize him to provide digital content/information), and

a control unit (Ramachandran: "computer processor 12"), for actuating said output device to provide the content of a multimedia file from the content provider selected by said input device under control of authorization information read from the user's smart card as already described above) and wherein the content is not provided from an integrated circuit card (Ramachandran: Figure 1).

Ramachandran does not disclose another integrated circuit card interface for receipt of a host integrated circuit card containing authorization information and the control unit, responsive to responsive to the host and user integrated circuit cards being received in the integrated circuit card interfaces which compares the authorization information from both the host and the user cards and when these two authorization information found to be compatible actuates said output device to provide the digital multimedia content.

However, in the same field of endeavor of allowing controlled access to downloadable digital information from a content provider, Handelsman discloses another integrated circuit card interface for receipt of a host integrated circuit card containing authorization information and the control unit, responsive to the host and user integrated circuit cards being received in the integrated circuit card interfaces which compares the authorization information from both the host and the user cards and when these two authorization information found to be compatible actuates said output device to provide the digital multimedia content (see at least Fig.1 and col.7, line 35-col.8, line 10. Fig.1 shows two interfaces for receiving integrated circuit cards, that is reference numbers "24" and "26" one from the host, that is main card I receptacle 24 and another from the user, that is the parent card in receptacle 26 and reference number "10", that is the decoder unit corresponds to the claimed control unit. In Handelsman, decoder unit 10, that is the control unit in response to receiving both the cards inside their receptacles compares the authorization information from both the cards and when the authorized information is compatible, that is it actuates the output device to display TV shows,

depending if the parental card is there then all programs can be shown and if parent card is not there then only unrestricted programs are viewable). In view of Handelman, at the time of the applicant's invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of Ramachandran of identifying the user for providing multimedia content files to have included the system of Handelman in order to be able to control providing multimedia files so that the children or other users are not able to view data restricted for them as taught in Handelman.

Referring to claim 2, Ramachandran in view of Handelman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system comprising a multimedia terminal having said content provider, said first integrated circuit card interface said control unit therein enclosed therein (Ramachandran: Fig. 2).

Referring to claims 3-4. Ramachandran in view of Handelman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said output device comprises an audio and video output device (Ramachandran: col. 7, lines 49-59).

Referring to claim 5. Ramachandran in view of Handelman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said output device comprises a

communication link permitting downloading of the selected multimedia file in electronic form (Ramachandran. col. 7, lines 49-59).

Referring to claim 6. Ramachandran in view of Handelsman discloses a system according to claim 5 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said communication link is a wireless communication link (Ramachandran: col. 4, lines 37-49).

Referring to claims 7-8. Ramachandran in view of Handelsman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said input device, said output device, and said control unit comprise a Laptop computer and a wireless personal terminal (Ramachandran: col. 4, lines 37-49).

Referring to claim 9. Ramachandran in view of Handelsman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said content provider comprises a server (Ramachandran'. Fig. 1).

Referring to claim 10. Ramachandran in view of Handelsman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said content provider further

comprises a mainframe computer coupled to said server (Ramachandran: Fig. 1)

Referring to claim 11. Ramachandran in view of Handelman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system comprising a server connected to said content provider (Ramachandran: Fig. 1).

Referring to claim 12. Ramachandran in view of Handelman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system comprising a mainframe computer connected to said server (Ramachandran: Fig. 1).

Referring to claims 13-14. Ramachandran in view of Handelman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said multimedia files comprise audio and video media (Ramachandran: abstract).

Referring to claims 15-18. Ramachandran in view of Handelman discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said video media comprises text, books, newspapers and games (Ramachandran: col. 6, lines 53-62).

Referring to claims 19-23, their limitations are closely parallel to the limitations of claims 1-5 and are therefore rejected under the same rationale as set forth above in claims 1-5.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,823,172 to Forrest discloses a self-service terminal having a plurality of intercommunicating terminals for providing services, such as dispensing cash , printing receipts, etc. (see at least col.1, lines 1-30)

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

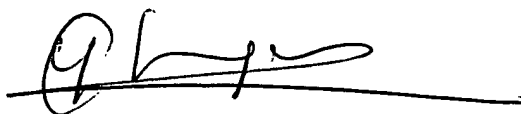
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
September 29, 2005